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Reginald J. Hill
Name of applicant, assignee, or Registered Rep.

Signature

April 19, 2004
Date

Patent
09/366,896

Attorney Docket
No. 42430-10030

AF/2642
22W
#11
SMY
4/26/04

IN THE UNITED STATES
PATENT AND TRADEMARK OFFICE

Patent Application

Inventors Paul Norman Burgess
Serial No. 09/366,896
Filing Date August 4, 1999
Examiner W. Deane, Jr.
Group Art Unit 2642

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APR 23 2004

Technology Center 2600

Title Method and Apparatus for Assigning Telephone Numbers

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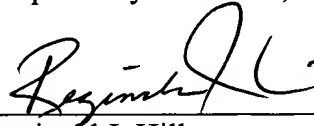
SIR:

LETTER SUBMITTING APPEAL BRIEF

Enclosed is the appeal brief of Applicant Paul Norman Burgess for the above-captioned patent application. Please charge the fee under 37 CFR 1.17(c) of \$330 to deposit account 10-0460.

Please charge any required additional payment or credit to deposit account 10-0460.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Reginald J. Hill", written over a horizontal line.

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April 19, 2004

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

----- X
In re Application of: :

Paul Norman Burgess :

Serial No.: 09/366,896 :

Filed: August 4, 1999 :

For: METHOD AND APPARATUS FOR ASSIGNING
TELEPHONE NUMBERS

Art Unit 2642

Examiner William J. Deane, Jr.

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APPEAL BRIEF

I. REAL PARTY IN INTEREST

Lucent Technologies Inc., a Delaware corporation, the assignee, is the real party in
interest.

II. RELATED APPEALS AND INTERFERENCES

Appellant and Appellant's legal representative know of no other appeals or interferences
which will be directly affected by or which will directly affect the Board's decision in this
pending appeal.

III. STATUS OF CLAIMS

Claims 1-12 and 19-26 are pending in the application and are finally rejected by the
Examiner. More specifically, claims 1, 5, 9 and 11-12 are rejected under 35 U.S.C. § 103(a) as
being unpatentable over Leskinen, U.S. Patent No. 6,085,081. Claims 2-4, 6-8 and 10 are
rejected under 35 U.S.C. § 103(a) as being unpatentable over Leskinen in view of Fougnes et al.

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("Fougnyes"). Claim 8 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Leskinen in view of Fukuzawa et al., U.S. Patent No. 6,327,353 ("Fukuzawa"). And, claims 19-26 are rejected "in a like manner to the claims above."¹ Appellant appeals the rejection of claims 1-12 and 19-26.

IV. STATUS OF AMENDMENTS

Appellant filed no amendments after the final rejection.

V. SUMMARY OF THE INVENTION

Applicants' invention is directed to a method and apparatus for assigning telephone numbers in a telecommunications system in a manner to conserve the number of telephone numbers required. (Specification, page 1, lines 6-9.) More specifically, the present invention discloses and claims a method and apparatus for assigning telephone numbers such that outgoing calls may be made but no incoming number is associated with a communications device or communications line. (Id. at page 2, lines 14-23.) Omitting the incoming telephone number conserves telephone numbers and restricts incoming calls. (Id.)

In accordance with the method, a unique equipment identifier (222, 122b) is assigned either to the communications device (200) or to a communications line (110b). (Id. at page 2, lines 15-16.) However, no telephone number is associated with the communications device or line. (Id. at page 2, lines 16-18.) Thus, the communications device or line can receive no incoming calls. (Id. at page 2, line 18.) The equipment identifier is used to facilitate outgoing telephone calls. (Id. at page 2, lines 18-19.) Therefore, in spite of lacking a telephone number,

¹ In the Office Action mailed on April 9, 2003, the Examiner did not elaborate on the rejection of added claims 19-26 other than to indicate those claims were rejected "in a like manner to the claims [1-12] above." In section VII.B herein, the Appellant presumes an application of the art to the claims consistent with similarity of the recited elements and the Examiner's rejections of claims 1-12.

the communications device or line is capable of originating telephone calls. (Id. at page 2, lines 19-21.) By omitting a telephone number from assignment with a communications device or line, telephone numbers are conserved. (Id. at page 2, lines 21-23.)

In accordance with the apparatus, a communications device (200) includes a memory (210). (Id. at page 3, lines 22-23.) The memory stores an equipment identifier that uniquely identifies a communications device or line, wherein no incoming call is receivable and outgoing calls are operably placed using the communications device or line based on the equipment identifier. (Id. at page 3, lines 23-26.) No telephone number is associated the communications device or line for the purpose of receiving incoming calls. (Id.)

According to certain additional features, where a telephone number is required for purposes other than receiving an incoming phone call, an already assigned telephone number is used with the communications device or line. (Id. at page 2, lines 23-30.) That is, a telephone number associated with another communications device or line is usable in place of a telephone number for the communications device or line. (Id.) For example, another telephone number associated with a user is optionally associated with the communications device or line for the purposes of billing, calling line identification, and automatic number identification. (Id.)

VI. ISSUES

Whether a *prima facie* case of obviousness is shown where all the claim limitations are not taught or suggested by the Leskinen reference.

Whether a *prima facie* case of obviousness is shown where, barring hindsight, there is no motivation to combine the Leskinen reference with either the Fougnyes or Fukuzawa references.

VII. GROUPING OF CLAIMS

For purposes of this appeal, as the issues are framed, claims 1-12 and 19-26 stand or fall together on the issue of whether Leskinen teaches or suggests a device that inhibits incoming calls. On the issue of whether there is a motivation to combine Leskinen with Fougnyes, claims 2-4, 6-8, 10, 20-23, and 24-25 stand or fall together. On the issue of whether there is motivation to combine Leskinen with Fukuzawa, claims 8 and 26 stand or fall together.

VIII. ARGUMENT

A. *A Prima Facie Case of Obviousness Is Not Shown Because All the Claim Limitations Are Not Taught or Suggested By Leskinen.*

The Examiner rejected all the pending claims 1-12 and 19-26 under 35 U.S.C. § 103(a) as being unpatentable over Leskinen alone or Leskinen in combination with Fougnyes or Fukazawa. According to the Examiner, in every rejection, Leskinen teaches the claimed device and method, except for explicitly teaching that the device inhibits incoming calls. The Examiner argues that Leskinen implicitly teaches that the device inhibits incoming calls. The Appellant disagrees with the Examiner. Leskinen fails to explicitly or implicitly teach a device that inhibits incoming calls. Hence, the Examiner's rejections which rely upon Leskinen for this limitation, are improper because no *prima facie* case of obviousness is established.

A *prima facie* case of obviousness requires, among other things, that the prior art reference or references must teach or suggest all the claim limitations. MPEP § 2142 (citing *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991)). According to the Examiner, the device disclosed in Leskinen is only for outgoing calls. And, hence, inhibiting incoming calls is contemplated by Leskinen. A fair reading of Leskinen makes it clear that this is simply not the case.

Leskinen discloses a method and apparatus for temporarily assigning a user identification to a mobile telephone user. That is, a user identification is dynamically allocated upon setting up a connection. According to the teachings of Leskinen, a mobile station is allocated a temporary user identification. That user identification is then used to place calls over the wireless network. Leskinen is silent on whether incoming calls may be received by the mobile station using the temporary identification. Although, the receipt of incoming calls is implied.

The examiner cites to two areas of Leskinen in support of his assertion that the Leskinen device "is only for outgoing calls." (Office Action mailed September 25, 2002.) First the examiner cites to Leskinen, column 3, lines 11-15, which state: "In view of persons who seldom need a mobile station, it is also not reasonable to make a subscriber agreement, because the person should anticipate his or her possible need for making calls well in advance." Lack of a subscriber agreement does not indicate that only outgoing calls are made. Then the examiner cites to Leskinen, column 4, lines 35-39, which state: "If the SIM card is not in its place or it is defective or the data is not reasonable for another reason, it is usually not possible in known mobile communication networks to make a call from the mobile station 1, except maybe to a predetermined special number, such as the emergency number." The passages relied upon by the Examiner do not indicate that the Leskinen device only supports outgoing and not incoming calls.

Moreover, other passages in Leskinen clearly indicate that while a Leskinen device is connected to the mobile network using the temporary identification, the device is afforded all services of the network, which presumably includes incoming calls. For example, in column 8, lines 59-65, Leskinen states, with respect to a mobile station connected using a temporary identification, that:

The mobile station 1 operates now like a **normal** mobile station that can be connected to the mobile communication network 2 in question, wherein the user of the mobile station 1 has access to those services of the mobile communication network 2 for which the teleoperator of the mobile communication network has given the access rights also to users without a user identification of their own.

(emphasis added).

In other words, once the mobile station is connected, it can be afforded normal services, which normally include incoming calls. Furthermore, Leskinen suggest that the temporary user identification is displayed to the user (column 8, lines 3-6), which implies the user might use that, for example, in receiving incoming calls. Also, Leskinen suggest that the invention disclosed therein is analogous to public telephones, which have incoming numbers associated therewith. *See*, Leskinen, column 4, lines 6-9.

Independent claim 1 requires, among other things, “omitting association of a telephone number with the unique equipment identifier, thereby inhibiting incoming calls.” Similarly, independent claim 11 requires a communication device “wherein no incoming call is receivable and outgoing calls are operably placed.” And, independent claim 12 recites a telecommunication switch “wherein at least one of the plurality of lines has no assigned telephone number for receiving incoming calls and has a capability to originate outgoing calls.” Independent claim 19 requires, among other things, “omitting association of a telephone number with the unique equipment identifier to inhibit incoming calls to the communications line.” Leskinen does not teach or disclose these novel features, explicitly, inherently or otherwise. Hence, claims 1, 11, 12 and 19 are novel and not obvious in view of Leskinen. Claims 2-10 and 20-26, which ultimately depend from claim 1 and claim 19, respectively, are patentable for at least the reasons given above with respect to claim 1 and claim 19.

The Examiner has failed to set forth a *prima facie* case of obviousness in any rejections using Leskinen. In particular, there is no teaching, disclosure or suggestion in Leskinen to

inhibit incoming calls, as required by each of the independent claims of the present invention.

Therefore, all the claims are patentable and unobvious.

B. A *Prima Facie* Case of Obviousness Is Not Shown Because There Is No Motivation to Combine Leskinen With Either Fournies or Fukuzawa.

The Examiner rejected claims 2-4, 6-8 and 10 under 35 U.S.C. § 103(a) as being unpatentable over Leskinen in view of Fournies. And, the Examiner rejected claim 8 under 35 U.S.C. § 103(a) as being unpatentable over Leskinen in view of Fukuzawa. Presumably, the Examiner rejected claims 20-23 and 24-25 under 35 U.S.C. § 103(a) as being unpatentable over Leskinen in view of Fournies and rejected claim 26 under 35 U.S.C. § 103(a) as being unpatentable over Leskinen in view of Fukuzawa.² In addition to and as an alternative to the arguments for patentability given above, claims 2-4, 6-8, 10, 20-23 and 24-25, are patentable, because a *prima facie* case of obviousness is lacking for these claims. In particular, there is no motivation to combine Leskinen with Fournies or Fukuzawa.

According to the Examiner, with respect to claims 2-4, 6-8, 10, 20-23 and 24-25, Leskinen teaches the claimed device, except for assigning a currently assigned telephone number with the communications device for billing, maintenance, ANI, and calling number identification. Fournies is cited for supplying the missing teachings. With respect to claims 8 and 26, the Examiner indicates that Leskinen discloses the claimed invention, except for initiating temporary assignment of a telephone number based on a call. The examiner uses Fukuzawa for the missing element.

² The Examiner did not explicitly specify the basis for the rejection of claims 19-26, other than to indicate those claims were rejected "in a like manner to the" other claims. In this appeal, due to the similarity in recitations, claims 20-26 are treated as being rejected like claims 2-8, respectively.

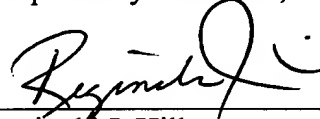
For an obviousness rejection to be proper there must be a motivation to modify a reference or combine reference teachings. MPEP § 2143 (citing *In re Vaeck*). The teaching or suggestion to make the claimed combination must be found in the prior art, not in applicant's disclosure. *Id.* There simply is no motivation to combine Leskinen and Fougnes or Leskinen and Fukuzawa.

The Examiner provides no motivation to make the combinations used in rejecting these claims. Leskinen's teachings are discussed above. Notably, Leskinen is silent with respect to the conservation of telephone numbers generally and specifically silent with respect to inhibiting incoming calls. Fougnes is directed to a security feature for cellular communications systems. More specifically, Fougnes relates to a security feature that allows only pre-authorized users to complete cellular calls. Fougnes is not concerned with conservation of telephone numbers generally and is not concerned with inhibiting incoming calls as a means to conserve telephone numbers specifically. Fukuzawa is directed to permitting temporary use of a telephone number. This temporary or "virtual" number clearly is used for incoming calls once it is assigned, which is in conflict with the claims of the present invention. *See*, Fukuzawa, Abstract, lines 9-16. Clearly Fukuzawa is not concerned with inhibiting incoming calls as a means to conserve telephone numbers. Given the distance between the references in disclosure, teaching, subject matter and even recognition of the problems addressed, short of hindsight, there is no motivation to make the combinations used. Therefore, the obviousness rejections are improper for failing to establish a *prima facie* case of obviousness.

C. Conclusion

The Examiner's rejection of all claims using Leskinen is improper because Leskinen does not teach or suggest inhibiting incoming calls, as claimed. Additionally, and alternatively, the rejections of claims 2-4, 6-8, 10, 20-23 and 24-26 using Leskinen in combination with Fougnes or Fukazawa are improper because there is no motivation to combine these references. Removal of the improper rejections places all pending claims in condition for allowance.

Respectfully submitted,



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April 19, 2004

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IX. APPENDIX

1. A method for assigning a telephone number to a communications device or line comprising the steps of:

- A) assigning a unique equipment identifier to the communications device or line;
- B) associating the unique equipment identifier with a telecommunications network such that an outgoing call may be originated from the communications device or line that has the unique equipment identifier; and
- C) omitting association of a telephone number with the unique equipment identifier, thereby inhibiting incoming calls to the communications device or line by lack of a telephone number being associated therewith.

2. The method of claim 1 further comprising the step of :

- D) associating a currently assigned telephone number with the communications device or line for billing.

3. The method of claim 1 further comprising the step of:

- D) associating a currently assigned telephone number with the communications device or line for maintenance on the communications device or line.

4. The method of claim 1 further comprising the step of:

- D) associating a currently assigned telephone number with the communications line or device for automatic number identification.

*Continued
Page 2, line
17, spec.*

5. The method of claim 1 further comprising the step of:
 - D) associating a currently assigned telephone number with the communications line or device for purposes other than receiving an incoming telephone call.
6. The method of claim 1 further comprising the step of:
 - D) associating a currently assigned telephone number with the communications line or device for calling number identification.
7. The method of claim 1 further comprising the step of:
 - D) temporarily assigning an unassigned telephone number to the communications device or line in response to a request for a temporary telephone number
8. The method of claim 7 wherein the request for a temporary telephone number is initiated by a telephone call.
9. The method of claim 1 wherein the communications device is a wireless telephone.
10. The method of claim 7 wherein the unassigned telephone number is assigned for a predetermined period of time.
11. A communications device comprising:
 - a memory storing a unique equipment identifier, the equipment identifier uniquely identifying a communications device or line, wherein no incoming call is receivable and

outgoing calls are operably placed using the communications device or line based on the equipment identifier, and wherein no telephone number is associated the communications device or line for the purpose of receiving incoming calls.

12. A telecommunications switch comprising:

a plurality of lines for outgoing and incoming telephone calls;
a memory associated with each line of the plurality of lines;
the memory storing an equipment identifier used to communicate with each line; and
wherein at least one of the plurality of lines has no assigned telephone number for receiving incoming calls and has a capability to originate outgoing calls.

19. A method for assigning a telephone number to a communications line comprising the steps of:

A) assigning a unique equipment identifier to the communications line;
B) associating the unique equipment identifier with a telecommunications network such that an outgoing call may be originated from the communications line that has the unique equipment identifier; and
C) omitting association of a telephone number with the unique equipment identifier to inhibit incoming calls to the communications line by lack of a telephone number being associated therewith.

20. The method of claim 19 further comprising the step of :

D) associating a currently assigned telephone number with the communications line for billing.

21. The method of claim 20 further comprising the step of:

E) associating a currently assigned telephone number with the communications line for maintenance on the communications line.

22. The method of claim 21 further comprising the step of:

F) associating a currently assigned telephone number with the communications line for automatic number identification.

23. The method of claim 22 further comprising the step of:

G) associating a currently assigned telephone number with the communications line for purposes other than receiving an incoming telephone call.

24. The method of claim 23 further comprising the step of:

H) associating a currently assigned telephone number with the communications line for calling number identification.

25. The method of claim 19 further comprising the step of:

D) temporarily assigning an unassigned telephone number to the communications line in response to a request for a temporary telephone number.

26. The method of claim 25 wherein the request for a temporary telephone number is initiated by a telephone call.